

Remarks

Status of the Claims

Claims 1-4 and 6-22 are pending in the application. All claims stand rejected. By this paper, claims 1, 2, 6-9, 11, 12, and 14-21 have been amended. Reconsideration of all pending claims herein, as amended, is respectfully requested.

Claim Rejections

Claims 12 and 15 were rejected under 35 U.S.C. 102(e) as being anticipated by Katz. Claims 1-3, 9-11, 16, 17, and 19-21 were rejected under 35 U.S.C. 103(a) as being unpatentable over Katz in view of Perlman et al. ("Perlman"). Claims 4, 6, 8, 13, and 22 were rejected under 35 U.S.C. 103(a) as being unpatentable over Katz, Perlman, and further in view of Walker et al. ("Walker"). Claims 7, 14, and 18 were rejected under 35 U.S.C. 103(a) as being unpatentable over Katz, Perlman, and further in view of Omoigui. These rejections are respectfully traversed for the reasons discussed below.

The claims have been amended to make explicit what the applicant believes was already implicit in the rejected claims. As amended, claim 1 recites a method for screening a participant's comments or questions for content in an interactive discussion show, comprising:

for each participant desiring to provide a comment or question to be discussed in the show:

receiving the participant question or comment and subsequently disconnecting a communication link with the participant before the question or comment is discussed to allow the communication link to be reused by other participants;

storing the participant comment or question in a storage location;

automatically processing the stored participant comment or question to determine a relationship of the participant comment or question to the show;

based on the determined relationship, alerting the participant if the participant comment or question is selected for discussion in the show; and

reconnecting the communication link with the participant to allow the participant to interactively discuss the participant comment or question in the show.

These claimed features eliminate the need for participants of interactive discussion shows, such as "call-in" shows, to stay actively "tuned in" while waiting for their comments or questions to be discussed in the show. Participants are only connected with the interactive discussion show for a brief time to allow a comment or question to be stored. The stored comment or question is then processed (screened) to determine its relationship (relevance) to the show. For instance, during a call-in show, the participant's comment or question may be screened to determine whether it relates to the current topic of discussion or whether it contains inappropriate subject matter.

If, at some point during the show, the participant's comment or question is deemed relevant or otherwise selected for discussion in the show, the participant is alerted using a pre-selected method, e.g., a telephone call, voicemail, facsimile, email, instant message, screen alert, etc. The participant may then be re-connected with the interactive show to allow the participant to interactively discuss the comment or question in the show.

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Advantageously, these claimed features eliminate waiting time for participants, since they may engage in other activities while their comment or question is being considered for possible use, discussion, etc. Furthermore, the interactive show needs fewer communication lines, since participants are not placed on hold for extended periods of time.

Katz Teaches Random Selection of a Winner/Loser, which is the Antithesis of Processing Stored Input to Determine a Relationship with the Show

Even without the claim amendments, Katz does not satisfy all of the limitations of claim 1 attributed to it by the Examiner. With respect to the previously-claimed step of "automatically processing the stored participant input to determine a relationship of the participant input to the show," the Examiner refers to Figure 6 and associated discussion at col. 13, lines 9-27 of Katz, pointing out that Katz determines a winner or loser. However, a closer look at this process reveals that Katz determines the winner or loser randomly, e.g., by comparing a random number with the participant's telephone number. In Katz, no participant "input" is processed, nor is a "relationship" of the input determined with respect to the show, as originally claimed.

A telephone number is not participant "input" because it is not selected by the participant for the show. The applicant successfully argued this point with respect to the previously-cited Yoshinobu, which limited inbound calls based on the user's telephone number. The argument apparently had merit, because the reference was withdrawn. Katz is no different from Yoshinobu in this respect.

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Random selection based on the participant's telephone number cannot mean "screening participant input [comments/questions] for content," as recited in the preamble of claim 1. One's telephone number is not "content" or even "input," much less a "comment or question." Moreover, in Katz, there is no attempt to determine the "relationship" (claim 1) or "relevance" (claim 12) of the input to the show, as claimed. A telephone number matching a random number is not normally a gauge of "relevance."

Katz and Perlman Do Not Disclose Reconnecting with the Participant to Obtain Additional Input

The Examiner notes that a participant in Katz can "dial up again to reestablish the connection to the show and enter[] Identification data for prize redemption [which] is well known in the art." The applicant respectfully points out that Katz does not disclose or suggest reconnection with an interactive show after disconnection. To the extent that the Examiner is taking Official Notice of this limitation, the applicant respectfully requests that the Examiner do so formally.

The Examiner points to Perlman for "reconnecting the communication to receive additional input from the participant whose input is selected for the show (page 5, [0047]). However, Perlman teaches completely the opposite. According to the cited portion of Perlman, "the client 1 automatically disconnects from the WebTV™ server 5 when no input from the user is received for a predetermined period of time." (Emphasis added). Perlman says nothing about disconnection after receiving input, only disconnection after receiving no input. Thus, Perlman teaches away from the claimed invention.

More fundamentally, none of the references are directed to the applicant's problem of overcrowded telephone lines in an interactive discussion show. None of the references teach or suggest the claimed disconnection/reconnection mechanism as a means of solving the applicant's problem. Accordingly, the applicant respectfully submits that the cited references cannot show the claimed invention "as a whole." In determining obviousness, "the inquiry is not whether each element existed in the prior art, but whether the prior art made obvious the invention as a whole for which patentability is claimed." *Hartness International, Inc. v. Simplimatic Engineering Co.*, 819 F.2d 1100, 2 U.S.P.Q.2d 1826 (Fed. Cir. 1987).

Lacking any discussion of the problems faced by the applicant or the applicant's solution to the problem, it is difficult to see how the proposed combination could yield the claimed invention. One of ordinary skill in the art is simply left with two disparate references directed to very different problems. "[I]t is impermissible to use the claimed invention as an instruction manual or 'template' to piece together the teachings of the prior art so that the claimed invention is rendered obvious. . . . This court has previously stated that '[o]ne cannot use hindsight reconstruction to pick and choose among isolated disclosures in the prior art to deprecate the claimed invention.'" *In re Fritch*, 23 U.S.P.Q.2d 1780, 1784 (Fed. Cir. 1992).

Katz and Perlman Do Not Teach a Method for Screening Participant Comments or Questions for an Interactive Discussion Show

As amended, claim 1 recites "comments or questions" rather than "input." As noted above, the claimed invention is about "screening" comments or questions for a interactive "discussion" show. It is not about running a contest, particularly a contest

that selects the winners and losers randomly, as taught by Katz. None of the cited references, alone or in combination, disclose:

- receiving the participant **question or comment...**
- storing the participant **comment or question** in a storage location;
- automatically processing the stored participant **comment or question** to determine a relationship of the participant comment or question to the show;
- based on the determined relationship, alerting the participant if the participant **comment or question is selected for discussion in the show;** and
- reconnecting the communication link with the participant **to allow the participant to interactively discuss the participant comment or question in the show.**

The cited references have nothing to do with interactive **discussion** shows. There is not a hint or suggestion of a participant interactively discussing a comment or question within one of Katz's contests or other activities for which statistical information is to be obtained. See Abstract.

Katz and Perlman Do Not Disclose or Suggest Disconnecting a Communication Link with the Participant *Before the Question or Comment is Discussed* to Allow the Communication Link to be Reused by Other Participants

Claim 1 recites disconnecting a communication link with the participant before the question or comment is discussed to allow the communication link to be reused by other participants. The immediate disconnection prior to the question or comment being discussed allows the question or comment to be screened for relevance, and additionally frees up communication lines, which addresses the applicant's problem of overcrowded lines.

By contrast, neither Katz nor Perlmán disclose or suggest disconnecting a communication link with the participant "before a question or comment is discussed." As noted above, neither reference discloses interactive discussion shows. Moreover, neither reference mentions reuse of communication links as a motivation for disconnecting the participant after receiving the question or comment but before the question or comment is discussed.

Conclusion

A rejection based on prior art – whether grounded in anticipation or obviousness – must account for each and every claim limitation. *Celeritas Techs. Inc. v. Rockwell Int'l Corp.*, 150 F.3d 1354, 1360, 47 U.S.P.Q.2d 1516, 1522 (Fed. Cir. 1998) (anticipation); *In re Wilson*, 424 F.2d 1382, 1385, 165 U.S.P.Q.2d 494, 496 (CCPA 1970) (obviousness); MPEP § 2143.03 ("To establish prima facie obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art.") (emphasis added). Because the references do not account for each and every claim limitation, as discussed above, the applicant respectfully submits that the prior art rejections should be withdrawn.

In view of the foregoing, the applicant respectfully submits that all pending claims herein are in condition for allowance. Early allowance of all pending claims is respectfully requested. If any issues remain, the Examiner is encouraged to contact the undersigned at the telephone number listed below.

Respectfully submitted,

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